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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,025	08/27/2001	Steven B. Volk	M-12039 US	4900
32605	7590	10/04/2004	EXAMINER	
MACPHERSON KWOK CHEN & HEID LLP 1762 TECHNOLOGY DRIVE, SUITE 226 SAN JOSE, CA 95110			BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/940,025	VOLK ET AL. <i>SG</i>
	Examiner Bradley Bayat	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 August 2001.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-16 is/are rejected.  
 7) Claim(s) 1-16 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 1-16 are presented for examination on the merits. Applicant's amendment filed on 26 November 26, 2001 has been entered.

### ***Claim Objections***

Claim 9 is objected to because of the following informalities: the applicant may perhaps replace the highlighted term “**write** the location on the writeable portion...” of the media disk to copy, replicate, input or as appropriate in a computing environment with regards to the claimed subject matter of the invention.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-16 are ejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1-3 and 10, the term "include" or "including" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For instance, in claim 3, the applicant indicates, "identifying the vendor from whom the media disk was purchased includes providing in the instructions, one of a code, a universal resource locator (URL)...." and so forth. Since the breadth of the claims are directed to identifying the location associated with a vendor and such location is clearly dependent on certain data, the applicant cannot rely on conditional language (i.e.,

including, such as, for example) because it fails to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

As per claims 4-7 are rejected as above.

As per claim 8, refers to a host as one of either an “engine, a device that embeds an engine...”etc. Claim 8 is indefinite, vague and fails to particularly point out and distinctly claim the subject matter claimed by the applicant.

As per claim 9, the use of conditional language “if” in the final step renders the rest of the claim indefinite.

As per claim 11-16 contain conditional language as above and are also indefinite and rejected as above.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-8, 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Christiano, U.S. Patent 5,671,412.**

As per the following claims, Christiano discloses:

1. A method of identifying a location associated with a vendor of a media disk holding content, the method comprising:

- providing instructions for the media disk (column 4, lines 35-57);
- during an install of the media disk into a host according to the instructions, installing an identifier on the media disk, the identifier including a code associated with the vendor (figure 2a and associated text, column 8, lines 5-56); and
- after transmitting data to a server, reading the identifier to find a location associated with the vendor, the location being associated with the vendor of the media disk and independent of any vendors that are not associated with the media disk (figure 12 and associated text).

2. The method of claim 1 wherein the instructions for the media disk include identifying a vendor from whom the media disk was purchased (figure 7 and associated text; column 15, line 45-column 16, line 39).

3. The method of claim 1 wherein the identifying the vendor from whom the media disk was purchased includes providing in the instructions one of a code, a universal resource locator (URL), a cryptographic key associated with the vendor, and a part of a cryptographic key associated with the vendor (figures 13-15 and associated text).

4. A system for identifying a location associated with a vendor of a media disk holding content, the system comprising: instructions for the media disk; and a software installation component

associated with the media disk, the software installation component installation during an install of the media disk into a host according to the instructions, the software installation component operable to install an identifier on the media disk, the identifier including a code associated with the vendor, the identifier associated with a location of the vendor to such that a connection between the host and a server is operable to open the location (column 23, line 24 – column 26, line 60).

5. The system of claim 4 wherein the instructions for the media disk include identifying a vendor from whom the media disk was purchased (figure 7 and associated text; column 15, line 45- column 16, line 39).

6. The system of claim 4 wherein the identifying the vendor from whom the media disk was purchased includes providing in the instructions one of a code, a universal resource locator (URL), a cryptographic key associated with the vendor, and a part of a cryptographic key associated with the vendor (figures 13-15 and associated text)

7. The system of claim 4 wherein the location is an Internet location including web pages for unlocking content stored on the media disk, the Internet location further providing optional offers for purchase over the Internet by the vendor (column 23, line 25 – column 26, line 10).

8. The system of claim 4 wherein the host is one of an engine, a device that embeds an engine, a

third party digital rights management protocol, and an application running in an open computing environment (figure1 and associated text; columns 1-2).

13. A system for identifying a location, the system comprising: a media disk having at least a writeable portion and a non-rewriteable portion, a media disk writing the location on the writeable portion; distributing one or more of the media disks to one or more entities, the location associating the media disks to the one or more entities; and if a return of the media disks occurs, altering the location according to predetermined conditions (column 23, line 24 – column 26, line 60).

14. The system of claim 13 wherein the media disk is one of a media disk, a compact disk, a digital video disk, and other digital storage mediums (column 6).

15. The method of claim 13 wherein an identifier is pre-recorded on the media disk and the media disk is pre-recorded, the identifier providing a link to the location (see background of the invention).

16. A computer program product, the computer program product comprising: signal bearing media having programming adapted to: instantiate during an install of the signal bearing media into a host according to instructions; and install an identifier on the signal bearing media, the identifier including a code associated with a vendor of hidden content on the signal bearing

media, the identifier associated with a location of the vendor to such that a connection between the host and a server is operable to open the location (rejected as above).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent 5,892,900 in view of Gebauer, U.S. Patent 6,415,288 B1.**

As per claim 9, Ginter et al. disclose a method of identifying a location via a media disk, the media disk having at least a writeable portion and a non-rewriteable portion, the method comprising: writing the location on the writeable portion; distributing one or more of the media disks to one or more entities, and if a return of the media disks occurs, altering the location according to predetermined conditions (column 264-269). Ginter et al. do not specifically disclose a method wherein the identified location is associated to the one or more media entities. Gebauer, however, teaches a method of mapping and identifying locations of various entities in any database<sup>4</sup> structure (column 3, line 50-column 5, line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ginter's DRM system to utilize a mapping system and method to locate nodes associated with a particular entity to determine the identity and location of a media source, as described in detail in Gebauer.

As per claim 10, Ginter et al. further disclose the method of claim 9 wherein the location is a universal resource locator (URL) and wherein the predetermined conditions include determining a market share of the one or more entities (figure 5B and associated text).

As per claim 11, Ginter et al. further disclose method of claim 9 wherein the altering the location is by a content provider, the content provider receiving the media disk, including one or more media disks, and distributing the returned media disks to same or different entities of the one or more entities after the altering (figures 6, 7 and associated text).

As per claim 12, Ginter et al. further disclose method of claim 11 wherein the distributing is pursuant to a lease agreement for media disks, the lease agreement allowing return of unsold media disks (figures 3-5B and associated text).

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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